

REMARKS

Applicants note that while the Examiner has checked the box stating, "This action is FINAL" in the Office Action Summary, the July 9, 2004 Office Action otherwise appears to be non-final. Furthermore, PAIR lists the July 9, 2004 Office Action as non-final. Thus, Applicants have treated the July 9, 2004 Office Action as non-final.

Claims 1-5, 7-13, 15, 18, and 21-44, of which claims 1, 8, 9, 15, 18, 21, 26, 27, 30, 33, 36, 37, and 43 are independent in form, are presented for examination.

Claim Rejections – 35 U.S.C. § 102

The Examiner has rejected claims 15, 18, and 26 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,265,104 ("Hull"). Claims 15 and 18 recite a method of making a metal-air battery, the method comprising placing a cathode tube in a can having a rectangular cross section. Claim 26 recites a method of making a metal-air battery, the method comprising placing a cathode tube in a can having a triangular cross-section.

But Hull does not anticipate claims 15, 18, and 26, at least because Hull does not disclose or suggest placing a cathode tube in a can having a rectangular or triangular cross-section. Hull discloses metal-air batteries that can be in the form of prismatic cells. (See, e.g., Hull, col. 6, lines 35-41.) The Examiner has asserted that, "since various embodiments of prismatic cells exist, prismatic can have a rectangular or a triangular cross section." (July 9, 2004 Office Action, page 5.) But the mere mention of a generic class or genus of cross-sectional shapes, without more, cannot anticipate Applicants' claims to a species of cross-sectional shape. As the Examiner has conceded, the genus of prismatic cross-sectional shapes encompasses different types of cross-sectional shapes (e.g., rectangular, triangular). In comparison, Applicants' claims cover the recited species of either a rectangular cross-section or a triangular cross-section. Accordingly, Applicants request that the rejection of claims 15, 18, and 26 be reconsidered and withdrawn.

Claim Rejections – 35 U.S.C. § 103

The Examiner has rejected claims 1-5, 7-13, 15, 18, and 21-44 under 35 U.S.C. § 103(a) as unpatentable over Hull in view of U.S. Patent No. 5,716,726 ("Cheiky"). However, at the time the claimed invention was made, both the claimed invention and the subject matter of Hull were owned by the same company or subject to an obligation of assignment to the same company (the Gillette Company). Thus, under 35 U.S.C. § 103(c), Hull is disqualified as § 102(e) / § 103(a) prior art against the claims of the subject application. Applicants accordingly request that the rejection of claims 1-5, 7-13, 15, 18, and 21-44 be withdrawn.

Information Disclosure Statement

Applicants filed an Information Disclosure Statement for the subject application in the U.S. Patent and Trademark Office on June 8, 2004, but have not yet received a copy of the initialed 1449 form from the Examiner. Applicants have enclosed a copy of the 1449 form with this Reply, and request that the Examiner provide confirmation that the cited references have been reviewed.

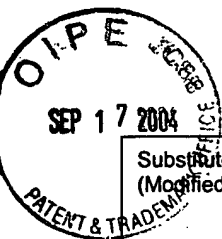
Applicants believe that the claims are in condition for allowance, which action is requested. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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| Substitute Form PTO-1449 (Modified) | U.S. Department of Commerce Patent and Trademark Office | Attorney's Docket No. 08935-218001 | Application No. 09/692,869 |
| Information Disclosure Statement by Applicant (Use several sheets if necessary) (37 CFR §1.98(b)) | | Applicant William McHugh, et al. | |
| | | Filing Date October 20, 2000 | Group Art Unit 1745 |

| U.S. Patent Documents | | | | | | | |
|-----------------------|-----------|-----------------|------------------|----------|-------|----------|----------------------------|
| Examiner Initial | Desig. ID | Document Number | Publication Date | Patentee | Class | Subclass | Filing Date If Appropriate |
| | AA | 6,350,537 | 02/26/02 | Pedicini | | | |
| | AB | 5,299,877 | 04/05/94 | Birden | | | |
| | AC | 4,180,624 | 12/25/79 | Winsel | | | |
| | AD | | | | | | |
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| Foreign Patent Documents or Published Foreign Patent Applications | | | | | | | | |
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| Examiner Initial | Desig. ID | Document Number | Publication Date | Country or Patent Office | Class | Subclass | Translation | |
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| | AL | WO 00/36696 | 06/22/00 | PCT | | | | |
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| Other Documents (include Author, Title, Date, and Place of Publication) | | |
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| Examiner Signature | Date Considered |
| EXAMINER: Initials citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. | |